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Bd 9 Appeal #26
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant : Donald F. Hamilton et al.
Serial No. : 08/777,958
Filed : December 24, 1996
Title : VEHICLE TRUNK WOOFER

Art Unit : 2644
Examiner : Ping W. Lee

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Hon. Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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BRIEF FOR APPELLANT

(1) REAL PARTY IN INTEREST

The real party in interest is Bose Corporation.

(2) RELATED APPEALS AND INTERFERENCES

Appeal No. 94-2403 in the parent application and Appeal No. 2000-1577 in this application may have a bearing on the Board's decision in the pending appeal.

(3) STATUS OF CLAIMS

Claims 1-10 stand rejected under 35 U.S.C. § 102(b) as being anticipated by and under 35 U.S.C. § 103(a) as unpatentable over "BAZOOKA Bass Tubes" (Car Audio and Electronics), and claims 1, 2, 4-7, 9 and 10 also stand rejected under 35 U.S.C. § 102(b) as being anticipated by and under 35 U.S.C. § 103(a) as unpatentable over Ziffer ("Pursuit of Perfection" "Car Audio and Electronics"). Claims 3 and 8 also stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ziffer as a primary reference in view of van Rijsbergen or "BAZOOKA Bass Tubes" ("Car Audio and Electronics") as a secondary reference.

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(4) STATUS OF AMENDMENTS

No amendment was filed subsequent to final rejection.

(5) SUMMARY OF INVENTION

The invention comprises an audio speaker system for a vehicle having a passenger compartment, a spare tire compartment, a trunk having a trunk floor, a dividing portion and a rear deck. The dividing portion, such as 11, (FIGS. 1 & 2) and rear deck, such as 3, divide the trunk, such as 7, and the passenger compartment of vehicle 1. The audio speaker system comprises at least one low frequency speaker, such as 9, disposed within the trunk of the vehicle at the trunk rear in a location spaced from the passenger compartment by the portion of the trunk extending to the front of the vehicle such that the at least one speaker is clear of the rear deck, above the trunk floor and outside the spare tire compartment. The at least one speaker is preferably disposed in a rearward section of the trunk occupying negligible useful trunk volume to cause a smaller decrease in calculated trunk volume than would occur with the one speaker mounted in the rear deck, preferably being disposed in a rear trunk corner at the rear of the vehicle and mounted in an enclosure. The vehicle audio speaker system is preferably constructed and arranged to be free of an undesirable peak in the rear seat frequency response of the vehicle between 80-100 Hz and free of an undesirable hole between 60-80 Hz in the front seat frequency response of the vehicle. The rear deck, such as 3, is preferably free of speaker holes. Page 2, line 11-page 3, line 25.

(6) ISSUES

1. Whether claims 1-10 are anticipated by the BAZOOKA Bass Tubes reference when this reference fails to disclose each and every element in each rejected claim arranged as in the claim.

2. Whether claims 1, 2, 4-7, 9 and 10 are anticipated under 35 U.S.C. § 102(b) by Ziffer when this reference fails to disclose each and every element in these rejected claims arranged as in the claim.

3. Whether claims 1-10 are unpatentable over BAZOOKA Bass Tubes under 35 U.S.C. § 103(a) when this reference fails to suggest the desirability of modifying what is there disclosed to meet the terms of these rejected claims.

4. Whether claims 1, 2, 4-7, 9 and 10 are unpatentable over Ziffer under 35 U.S.C. §103(a) when this reference fails to suggest the desirability of modifying what is there disclosed to meet the terms of these rejected claims.

5. Whether claims 3 and 8 are unpatentable over Ziffer as a primary reference in view of either van Rijsbergen or BAZOOKA Bass Tubes as a secondary reference when the references fail to suggest the desirability of combining what is there disclosed to meet the terms of these rejected claims.

➔ (7) GROUPING OF CLAIMS

The claims do not stand or fall together.

(8) ARGUMENT

I. CLAIMS 1-10 ARE NOT ANTICIPATED BY THE BAZOOKA REFERENCE AT LEAST BECAUSE THE CLAIMS REQUIRE THAT THE LOW FREQUENCY SPEAKER BE DISPOSED WITHIN THE TRUNK OF THE VEHICLE AT THE TRUNK REAR IN A LOCATION SPACED FROM THE PASSENGER COMPARTMENT BY THE PORTION OF THE TRUNK EXTENDING TO THE FRONT OF THE VEHICLE WHILE THE REFERENCE SHOWS THE LARGE BAZOOKA TUBES EXTENDING FROM FRONT TO REAR IN THE TRUNK IN THE LOCATION SPACED FROM THE PASSENGER COMPARTMENT BY THE PORTION OF THE TRUNK EXTENDING TO THE FRONT OF THE VEHICLE.

The final action states:

Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by "BAZOOKA Bass Tubes" ("Car Audio and Electronics").

It is noticed that the current invention as specified in the claims does not require the low frequency speaker being operational. Based on this interpretation, the claims are being rejected under 103 rejection in paragraph 5 below.

Assuming that the low frequency speaker is operational, the claims limitation are met in view of the discussion below.

Regarding claim 1, on the lower half of p. 41, a vehicle (sedan) is shown. A low frequency speaker (Bazooka woofers) is being disposed within the trunk of the vehicle clear of the rear deck, above the trunk floor and outside the spare tire compartment. Although not explicitly discussed, the sedan (Honda Accord, Toyota Camry, Nissan Pulsa, Nissan 200SX, BMW or Mercedes) inherently

includes a spare tire compartment, a trunk floor, a dividing portion and a rear deck.

Regarding claims 5 and 10, the limitation of these claims are not functionally related to the limitation in claims 1 and 6 since the claims never specify that the claimed frequency responses are caused by the woofer being placed in the trunk, not mounted on the rear deck as disclosed in the specification as originally filed as the prior art. With the low frequency speaker is disposed in the trunk as shown on p. 41, not conventionally mounted on the rear deck, the claimed frequency responses are inherently met (as discussed on p. 1 of the specification, the low frequency speaker mounted on the rear deck will cause a hole between 60-80 Hz for the front seat, and a hole between 80-100 Hz for the back seat).

Regarding claims 2, 3, 7 and 8, the low frequency speaker is disposed in a rearward section of the trunk ("The Bazooka woofers can be directed into the rearmost corner of the trunk (shown) or they can be located directly behind the back seat, whichever is preferable") and is disposed in a rear trunk corner at the rear of the vehicle (as shown in the diagram).

Regarding claims 4 and 9, as shown on p. 41, the low frequency speaker is mounted in an enclosure.

Regarding claim 6, as shown on p. 41, the rear deck is free of speaker holes when the low frequency speaker is placed on the trunk floor. Pp. 2-3.

Boilerplate
"It is well settled that anticipation under 35 U.S.C. 102 requires the presence in a single reference of all of the elements of a claimed invention." *Ex parte Chopra*, 229 U.S.P.Q. 230, 231 (BPA&I 1985) and cases cited.

"Anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim." *Connell v. Sears, Roebuck & Co.*, 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983).

"This court has repeatedly stated that the defense of lack of novelty (i.e., 'anticipation') can only be established by a single prior art reference which discloses each and every element of the claimed invention." *Structural Rubber Prod. Co. v. Park Rubber Co.*, 223 U.S.P.Q. 1264, 1270 (Fed. Cir. 1984), citing five prior Federal Circuit decisions since 1983 including *Connell*.

In a later analogous case the Court of Appeals for the Federal Circuit again applied this rule in reversing a denial of a motion for judgment n.o.v. after a jury finding that claims were anticipated. *Jamesbury Corp. v. Litton Industrial Prod., Inc.*, 225 U.S.P.Q. 253 (Fed. Cir. 1985).

After quoting from *Connell*, "Anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim," 225 U.S.P.Q. at 256,

the court observed that the patentee accomplished a constant tight contact in a ball valve by a lip on the seal or ring which interferes with the placement of the ball. The lip protruded into the area where the ball will be placed and was thus deflected after the ball was assembled into the valve. Because of this constant pressure, the patented valve was described as providing a particularly good seal when regulating a low pressure stream. The court quoted with approval from a 1967 Court of Claims decision adopting the opinion of then Commissioner and later Judge Donald E. Lane:

[T]he term "engaging the ball" recited in claims 7 and 8 means that the lip contacts the ball with sufficient force to provide a fluid tight seal. *** The Saunders flange or lip only sealingly engages the ball 1 on the upstream side when the fluid pressure forces the lip against the ball and never sealingly engages the ball on the downstream side because there is no fluid pressure there to force the lip against the ball. The Saunders sealing ring provides a compression type of seal which depends upon the ball pressing into the material of the ring. *** The seal of Saunders depends primarily on the contact between the ball and the body of the sealing ring, and the flange or lip sealingly contacts the ball on the upstream side when the fluid pressure increases. 225 U.S.P.Q. at 258.

Boilerplate
Relying on *Jamesbury*, the ITC said, "Anticipation requires looking at a reference, and comparing the disclosure of the reference with the claims of the patent in suit. A claimed device is anticipated if a single prior art reference discloses all the elements of the claimed invention as arranged in the claim." *In re Certain Floppy Disk Drives and Components Thereof*, 227 U.S.P.Q. 982, 985 (U.S. ITC 1985).

"A reference is only good for what it clearly and definitely discloses." *In re Hughes*, 145 U.S.P.Q. 467, 471 (C.C.P.A. 1965); *In re Moreton*, 129 U.S.P.Q. 227, 230 (C.C.P.A. 1961).

The copy of the BAZOOKA page furnished to us contains no page number or date and the drawings are faint white lines on a black background that nevertheless fails to disclose anything that anticipates the invention disclosed and claimed in this application.

Claim 1 requires that the low frequency speaker be disposed within the trunk of the vehicle at the trunk rear in a location spaced from the passenger compartment by the portion of the trunk extending to the front of the vehicle such that the at least one speaker is clear of the rear deck above the trunk floor and outside the spare tire compartment. The reference shows the

large BAZOOKA tubes extending from front to rear in the trunk IN the location spaced from the passenger compartment by the portion of the trunk extending to the front of the vehicle.

you / together
Claims 2 and 7-10 call for the at least one speaker being disposed in a rearward section of the trunk occupying negligible useful trunk volume to cause a smaller decrease in calculated trunk volume than would occur with said one speaker mounted in said rear deck. For at least these reasons, claims 2 and 7-10 are independently patentable over this reference.

Claims 5 and 10 further require that the vehicle is characterized by a front seat frequency response and a rear seat frequency response constructed and arranged to be free of an undesirable peak in the rear seat frequency response of the vehicle between 80-100 Hz and free of an undesirable hole between 60-80 Hz in the front seat frequency response of the vehicle. There is no disclosure whatsoever of the audio speaker system disclosed in the reference having this characteristic. For at least these reasons, claims 5 and 10 are independently patentable over this reference.

the picture shows there is no hole in the rear deck. Further, Ziffer is saying that there is a hole in the rear deck.
Furthermore, claims 6-10 call for the rear deck being free of speaker holes. There is no disclosure in this reference of the rear deck being free of speaker holes. For at least these reasons, claims 6-10 are independently patentable over the reference.

If this ground of rejection were repeated, the Examiner was respectfully requested to quote verbatim the language in the reference regarded as corresponding to each element in each rejected claim. The Examiner did not and can not comply with this request.

4-6
II. CLAIMS 1, 2, 4-7, 9 AND 10 ARE NOT ANTICIPATED BY ZIFFER AT LEAST BECAUSE THIS REFERENCE FAILS TO DISCLOSE THE LOW FREQUENCY SPEAKER DISPOSED WITHIN THE TRUNK OF THE VEHICLE AT THE TRUNK REAR IN A LOCATION SPACED FROM THE PASSENGER COMPARTMENT BY THE PORTION OF THE TRUNK EXTENDING TO THE FRONT OF THE VEHICLE.

The final action states:

Claims 1, 2, 4-7, 9 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Ziffer ("Pursuit of Perfection" by "Car Audio and Electronics").

It is noticed that the current invention as specified in the claims does not require the low frequency speaker being operational. Based on this interpretation, the claims are being rejected under 103 rejection in paragraph 6 below.

Assuming that the low frequency speaker is operational, the claims limitation are met in view of the discussion below.

Regarding claim 1, a vehicle (sedan) is shown on pps. 46-48. A low frequency speaker (Bazooka Bass Tubes) is being disposed within the trunk of the vehicle clear of the rear deck, above the trunk floor and outside the spare tire compartment. Although not explicitly discussed, the vehicle inherently includes a spare tire compartment, a trunk floor, a dividing portion and a rear deck.

Regarding claims 5 and 10, the limitation of these claims are not functionally related to the limitation in claims 1 and 6 since the claims never specify that the claimed frequency responses are caused by the woofer being placed in the trunk, not conventionally mounted on the rear deck as disclosed in the specification as originally filed. With the low frequency speaker is disposed in the trunk as shown on p. 48, not conventionally mounted on the rear deck, the claimed frequency responses are inherently met (as discussed on p. 1 of the specification, the low frequency speaker mounted on the rear deck will cause a hole between 60-80 Hz for the front seat, and a hole between 80-100 Hz for the back seat).

Regarding claims 2 and 7, the low frequency speaker is disposed in a rearward section of the trunk (the top picture on p. 48 shows the speaker is disposed on the rearward section of the trunk when one opens the trunk hood and view the speaker from the rear of the vehicle).

Regarding claims 4 and 9, as shown on p. 48, the low frequency speaker is mounted in an enclosure.

Regarding claim 6, as shown on p. 48, the rear deck is free of low frequency speaker holes when the low frequency speaker is placed on the trunk floor. As discussed by the entire article, no speaker is being mounted on the rear deck. Pp. 3-5.

There is no disclosure in this reference of having the low frequency speaker disposed within the trunk of the vehicle at the trunk rear in a location spaced from the passenger compartment by the portion of the trunk extending to the front of the vehicle such that the at least one speaker is clear of the rear deck above the trunk floor and outside the spare tire compartment as called for by all the claims. The poor quality copy of the reference furnished to us discloses the large BAZOOKA bass tubes extending from front to rear IN the portion of the trunk extending to the front of the vehicle.

There is no disclosure that the BAZOOKA bass tubes are disposed in a rearward section of the trunk occupying negligible useful trunk volume to cause a smaller decrease in calculated trunk volume than would occur with the one speaker mounted in the rear deck as called for by

claims 2, 3 and 7-10. These claims are independently patentable over the reference, for at least these reasons.

There is no disclosure of an audio speaker system wherein the vehicle is characterized by a front seat frequency response and a rear seat frequency response constructed and arranged to be free of an undesirable peak in the rear seat frequency response of the vehicle between 80-100 Hz and free of an undesirable hole between 60-80 Hz in the front seat frequency response of the vehicle as called for by claims 5 and 10. These claims are independently patentable over the reference, at least for these reasons.

Nor does the reference disclose that the rear deck is free of speaker holes as called by claims 6-10. These claims are independently patentable over the reference, at least for these reasons.

If this ground of rejection were repeated, the Examiner was respectfully requested to quote verbatim the language in the reference regarded as corresponding to each element in the rejected claims. The Examiner did not and cannot comply with this request.

III. CLAIMS 1-10 MEET THE CONDITIONS FOR PATENTABILITY OVER BAZOOKA BASS TUBES AT LEAST BECAUSE THE REFERENCE FAILS TO SUGGEST THE DESIRABILITY OF MODIFYING WHAT IS THERE DISCLOSED TO MEET THE TERMS OF THESE CLAIMS.

The final action states:

Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over "BAZOOKA Bass Tubes" ("Car Audio and Electronics").

It is noticed by the examiner, the current invention as specified in claims 1-10 does not require an audio input signal. Therefore, the limitation of the claims will also be met when someone purchases a woofer from a store and place it above the trunk floor. It would have been obvious to one of ordinary skill in the art to hide a purchased low frequency speaker within the trunk, above the trunk floor, outside of the spare tire compartment, just like placing a luggage in order to reduce the chance of being stolen. P. 5.

"The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

"The claimed invention must be considered as a whole, and the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination." *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick*, 221 U.S.P.Q. 481, 488 (Fed. Cir. 1984).

"Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under Section 103, teachings of references can be combined *only* if there is some suggestion or incentive to do so." *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984) (emphasis in original, footnotes omitted).

"The critical inquiry is whether 'there is something in the prior art as a whole *to suggest* the desirability, and thus the obviousness, of making the combination. [citing *Lindemann* with emphasis added.]" *Fromson v. Advance Offset Plate, Inc.*, 225 U.S.P.Q. 26, 31 (Fed. Cir. 1985).

We have shown above how it is impossible for this reference to anticipate claims 1-10. We incorporate by reference the reasoning set forth above distinguishing the rejected claims over the reference, including reasoning why claims are independently patentable. *Supra* 5-6.

If this ground of rejection were repeated, the Examiner was respectfully requested to quote verbatim the language in the reference regarded as corresponding to each element in each rejected claim and quote verbatim the language in the reference regarded as suggesting the desirability of modifying what is there disclosed to meet the terms of claims 1-10. The Examiner did not and can not comply with this request.

IV. CLAIMS 1, 2, 4-7, 9 AND 10 MEET THE CONDITIONS FOR PATENTABILITY UNDER SECTION 103 OVER ZIFFER AT LEAST BECAUSE THIS REFERENCE FAILS TO SUGGEST THE DESIRABILITY OF MODIFYING WHAT IS THERE DISCLOSED TO MEET THE TERMS OF THESE CLAIMS.

The final rejection states:

Claims 1, 2, 4-7, 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ziffer.

It is noticed by the examiner, the current invention as specified in claims 1, 2, 4-7, 9 and 10 does not require an audio input signal. Therefore, the limitation of the claims will also be met when someone purchases a woofer from a

store and place it above the trunk floor. It would have been obvious to one of ordinary skill in the art to hide a purchased low frequency speaker within the trunk, above the trunk floor, outside of the spare tire compartment, just like placing a luggage in order to reduce the chance of being stolen. Pp. 5-6.

We have shown above how it is impossible to anticipate claims 1, 2, 4-7, 9 and 10 with this reference. The Examiner has not identified anything in this reference which suggests the desirability of modifying what is there disclosed to meet the terms of these claims. We have also shown above and incorporate herein the remarks in support of claims being separately patentable over this reference, which reasoning is equally applicable to supporting their patentability under Section 103. *Supra* 7-8.

If this ground of rejection were repeated, the Examiner was respectfully requested to quote verbatim the language in the reference regarded as corresponding to each element in each rejected claim, and quote verbatim the language in the reference regarded as suggesting the desirability of modifying what is there disclosed to meet the terms of these claims. The Examiner did not and can not comply with this request.

V. CLAIMS 3 AND 8 MEET THE CONDITIONS FOR PATENTABILITY UNDER 35 U.S.C. § 103 OVER THE PRIMARY AND EITHER SECONDARY REFERENCE AT LEAST BECAUSE THESE REFERENCES FAIL TO SUGGEST THE DESIRABILITY OF COMBINING WHAT IS THERE DISCLOSED TO MEET THE TERMS OF THESE CLAIMS.

The final rejection states:

Claims 3 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ziffer in view of van Rijsbergen or "BAZOOKA Bass Tubes" ("Car Audio and Electronics").

Assuming that the low frequency speaker is operational, the claims limitation are met in view of the discussion below.

Regarding claims 3 and 8, Ziffer fails to show the low frequency speaker being disposed in the rear trunk corner at the rear of the vehicle. However, such a modification would have been an obvious design choice of the audio system installer without altering the overall sound quality.

As taught by van Rijsberge, "bass tone will travel through the car readily", so the "placement of the low range speakers can be quite flexible", and one can use his/her "imagination a little and find a place for woofers which would not otherwise fit in conventional mounting positions" (p. 21). Ziffer discloses a

custom fit/design audio system for a vehicle. The audio system installer would place the low frequency speaker at the location with minimal compromise of trunk space (p. 48), and as approved by the owner of the vehicle. By placing the low frequency speaker at the trunk corner at the rear of the vehicle, one skilled in the art would have expected that more space would be available behind the back seat, so the user could place luggage, articles, boxes, or other infrequently used objects below the rear deck.

The other article ("BAZOOKA Bass Tubes") also teaches that the bass tube can be place either behind the back seat or at the rear corner of trunk at the rear of the vehicle (as shown) depending on the preference.

Thus, it would have been obvious to one of ordinary skill in the art to modify the audio system as disclosed by Ziffer in view of van Rijsbergen or "BAZOOKA Bass Tubes" by locating the low frequency speaker at the rear trunk corner at the rear of the vehicle in order to provide more trunk space behind the back seat.

Furthermore, applicant discloses that any rear remote area of the trunk would be acceptable location for the low frequency speaker, and without specifying the reason to locate the speaker at the rear corner of the trunk of the rear of the vehicle other than a preference.

Shifting the location of the low frequency speaker in order to save trunk space and depending on preference is not a patentable invention. It merely involved common sense and/or mechanical skill in order to save space and/or better suit the preference of the user of the vehicle. Thus, it has been held to be within the general skill of a worker in the art to rearrange the location of the low frequency speaker as a matter of design choice. In re Japikse, 86 USPQ 70. Pp. 6-7.

"The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

"Although the Commissioner suggests that [the structure in the primary prior art reference] could readily be modified to form the [claimed] structure, '[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.'" *In re Laskowski*, 10 U.S.P.Q. 2d 1397, 1398 (Fed. Cir. 1989).

"The claimed invention must be considered as a whole, and the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination." *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick*, 221 U.S.P.Q. 481, 488 (Fed. Cir. 1984).

"Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under Section 103, teachings of references can be combined *only* if there is some suggestion or incentive to do so." *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984) (emphasis in original, footnotes omitted).

"The critical inquiry is whether 'there is something in the prior art as a whole *to suggest* the desirability, and thus the obviousness, of making the combination. [citing *Lindemann* with emphasis added.]" *Fromson v. Advance Offset Plate, Inc.*, 225 U.S.P.Q. 26, 31 (Fed. Cir. 1985).

As the Federal Circuit Court of Appeals said in *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999):

Close adherence to this methodology is especially important of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.'

And in *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000), the Court said:

[I]dentification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *See id.* [*Dembiczak*]. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. *See In re Dance*, 160 F.3d 1339, 1343, 48 U.S.P.Q.2d 1635, 1637 (Fed. Cir. 1998), *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. *See B. F. Goodrich Co. v. Aircraft Braking Sys. Corp.*, 72 F.3d 1577, 1582, 37 U.S.P.Q.2d 1314, 1318 (Fed. Cir. 1996).

The Examiner concedes that the primary reference fails to show the low frequency speaker being disposed in the rear trunk corner at the rear trunk corner of the vehicle. It is impossible to put these large BAZOOKA bass speakers in the rear trunk corner at the rear of the vehicle, and nothing in any of the references suggests the desirability of modifying anything there disclosed to meet the terms of claims 3 and 8. If this ground of rejection were repeated, the Examiner was respectfully requested to quote verbatim the language in each reference regarded

as corresponding to elements in claims 3 and 8 and quote verbatim the language in any of the references regarded as suggesting the desirability of combining what is there disclosed to meet the terms of claims 3 and 8. The Examiner did not and cannot comply with this request.

What the Examiner has done is used the claims being rejected as a blueprint or template for attempting to read the claims upon the prior art. That basis for rejection is not permitted.

Here, the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious.¹⁵ This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."¹⁶ *In re Fritsch*, 23 U.S.P.Q. 2d 1780, 1784 (Fed. Cir. 1992).

¹⁵ *In re Gorman*, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). See also *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985).

¹⁶ *In re Fine*, 837 F.2d at 1075, 5 USPQ2d at 1600.

Furthermore, rejections based on obvious design choice is a conclusion, not a reason for rejecting claims under Section 103. In *In re Garrett*, 33 PTCJ 43 (BPA&I, September 30, 1986) the Board criticized the Examiner's statement that the proposed modification would have been "an obvious matter of engineering design choice" as a conclusion, not a reason, in reversing the section 103 rejection.

✓ The reliance on *In re Japikse*, 86 U.S.P.Q. 70 (C.C.P.A. 1950) is inapposite. Apart from the decision ruling on "invention" before Section 103 was enacted in the Patent Act of 1952, the factual situation is completely different from that involved in this application. After discussing the confusing prosecution below where the court said, "We think it is regrettable that, if the examiner who prepared the statement following the appeal to the board was of the opinion that the prior art cited in the decision declared final by the first examiner was so deficient that the citation of additional art was required, he did not indicate that opinion clearly, because much confusion might have been avoided thereby," *id.* at 72, the Court found no error in the holding as to claim 3 where the claim read on a single reference where it was held that there would be no invention in shifting the starting switch disclosed by the reference to a different position since the operation of the device would not thereby be modified. *Id.* at 73.

The PTO is obligated to follow the authorities set forth above.

We take this occasion to explain what precedents are considered binding in proceedings in the Patent and Trademark Office (PTO). Where the Court of Appeals for the Federal Circuit has addressed a point of law in a published opinion, the Federal Circuit's decision is controlling. Similarly controlling are decisions considered to be binding precedent by the Federal Circuit, i.e., decisions of the former Court of Claims and the former Court of Customs and Patent Appeals, as well as the former Customs Court. See *South Corp. v. United States*, 690 F.2d 1368, 215 USPQ 657 (Fed. Cir. 1982)(in banc); *Bar Zell Expeditors, Inc. v. United States*, 698 F.2d 1210, 1211 n. 4 (Fed. Cir. 1983). In those relatively rare cases where the Federal Circuit has not addressed an issue, but there is "authorized published" Board precedent, that published Board precedent is binding on panels of the Board and Examiners in the Patent Examining Corps. *Ex parte Holt*, 19 U.S.P.Q. 2d 1211, 1214 (BPA&I 1991).

While not even mentioning the controlling authorities we cited, the final action places reliance on *In re Fine*, 5 U.S.Q.P. 2d 96 (Fed. Cir. 1988) and *In re Jones*, 21 U.S.P.Q. 2d 1941 (Fed. Cir. 1992) that is inapposite. In both cases, the Federal Circuit Court of Appeals reversed final rejections based on a combination of references failing to suggest the desirability of combining what was there disclosed to meet the terms of claims finally rejected and affirmed by the Board of Patent Appeals and Interferences.

In *Fine* the court said "The Board points to nothing in the cited references, either alone or in combination, suggesting or teaching Fine's invention." *Id.* 1599.

The court also said, "One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *Id.* 1600.

In *Jones* the court said, "Conspicuously missing from this record is any evidence, other than the PTO's speculation, (if it be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modifications of the prior art salts necessary to arrive at the claims II-(II'-aminoethoxy ethianol) salt." 21 U.S.P.Q. 2d at 1944.

CONCLUSION

In view of the foregoing reasoning and authorities and the inability of the references to anticipate, suggest or make obvious the subject matter as a whole of the invention disclosed and claimed in this application, the decision of the Examiner finally rejecting claims 1-10 should be

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reversed. Should the Board be of the opinion that one or more of the rejected claims may be allowed in amended form, the Board is respectfully requested to include an explicit statement that a claim may be allowed in such amended form and direct that Appellant shall have the right to amend in conformity with such statement which shall be binding on the Examiner in the absence of new references or grounds of rejection.

Since the brief fee was previously paid in connection with the prior appeal, no brief fee is believed to be due. Should a brief fee be due, the Office is respectfully requested to charge the brief fee to Patent Office Deposit Account No. 06-1050, Order No. 02103-211002, of the undersigned attorneys.

Respectfully submitted,

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Date: Oct 27 2003



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Enclosures: Drawing

(9) APPENDIX OF CLAIMS

1. An audio speaker system for a vehicle having a passenger compartment, a spare tire compartment, a trunk having a trunk floor, a dividing portion and a rear deck, said dividing portion and said rear deck dividing the trunk and the passenger compartment, said audio speaker system comprising at least one low frequency speaker disposed within the trunk of the vehicle at the trunk rear in a location spaced from the passenger compartment by the portion of the trunk extending to the front of said vehicle such that said at least one speaker is clear of the rear deck above said trunk floor and outside said spare tire compartment.

2. An audio speaker system in accordance with claim 1, wherein said at least one speaker is disposed in a rearward section of the trunk occupying negligible useful trunk volume to cause a smaller decrease in calculated trunk volume than would occur with said one speaker mounted in said rear deck.

3. An audio speaker system in accordance with claim 2, wherein said at least one speaker is disposed in a rear trunk corner at the rear of said vehicle.

4. An audio speaker system in accordance with claim 1, wherein said at least one speaker is mounted in an enclosure.

5. An audio speaker system in accordance with claim 1, wherein said vehicle is characterized by a front seat frequency response and a rear seat frequency response constructed and arranged to be free of an undesirable peak in the rear seat frequency response of said vehicle between 80-100 Hz and free of an undesirable hole between 60-80 Hz in the front seat frequency response of said vehicle.

6. An audio speaker system for a vehicle in accordance with claim 1 wherein said rear deck is free of speaker holes.

7. An audio speaker system in accordance with claim 6, wherein said at least one speaker is disposed in a rearward section of the trunk occupying negligible useful trunk volume to cause a smaller decrease in calculated trunk volume than would occur with said one speaker mounted in said rear deck.

8. An audio speaker system in accordance with claim 7, wherein said at least one speaker is disposed in a rear trunk corner at the rear of said vehicle.

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9. An audio speaker system in accordance with claim 7, wherein said at least one speaker is mounted in an enclosure.

10. An audio speaker system in accordance with claim 7, wherein said vehicle is characterized by a front seat frequency response and a rear seat frequency response constructed and arranged to be free of an undesirable peak in the rear seat frequency response of said vehicle between 80-100 Hz and free of an undesirable hole between 60-80 Hz in the front seat frequency response of said vehicle.

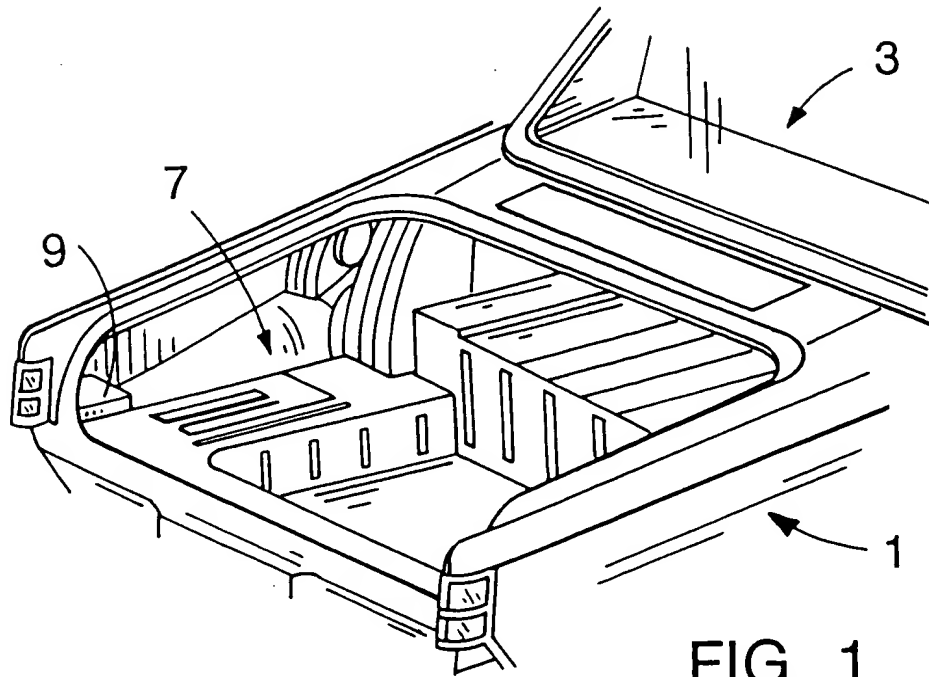


FIG. 1

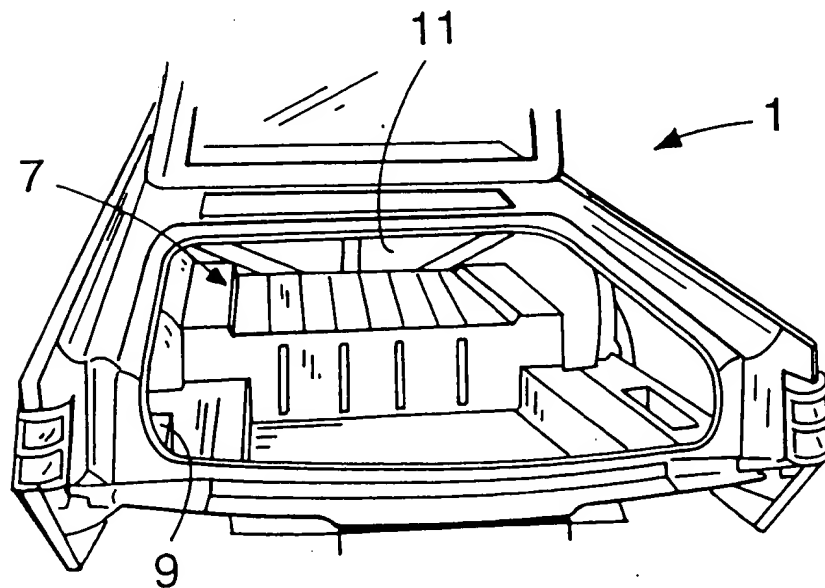


FIG. 2

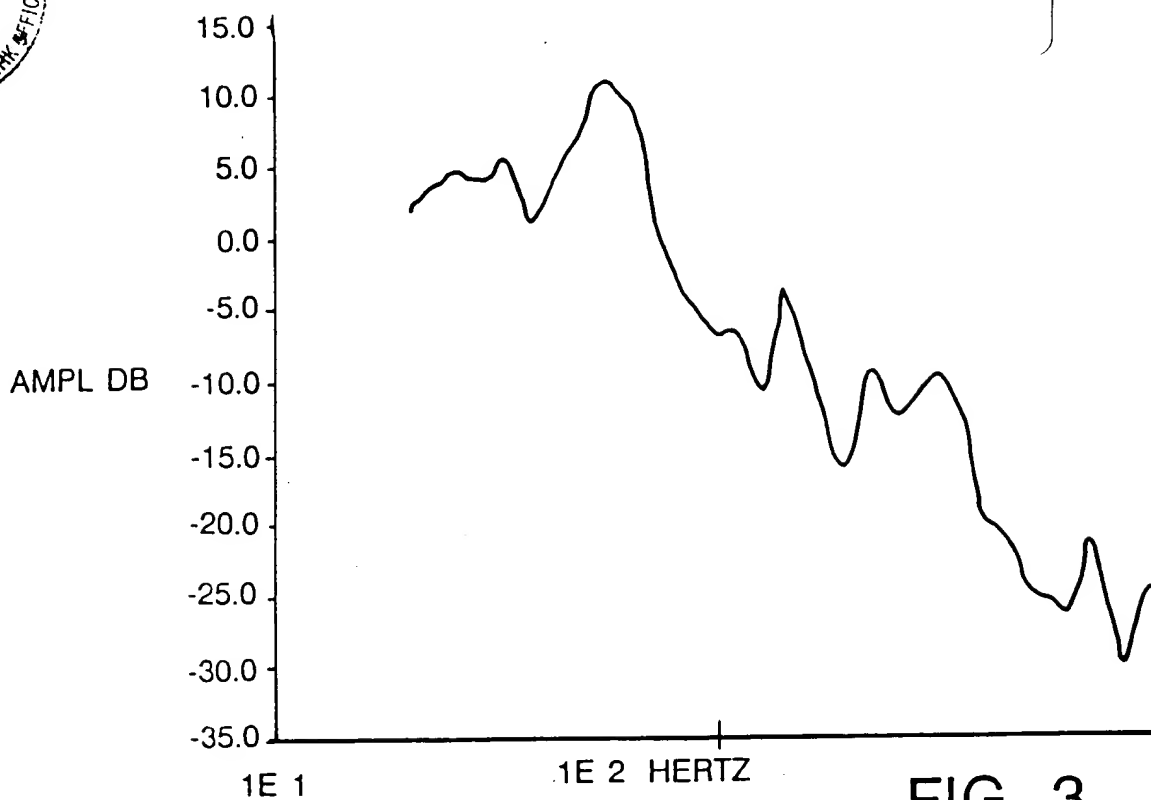


FIG. 3

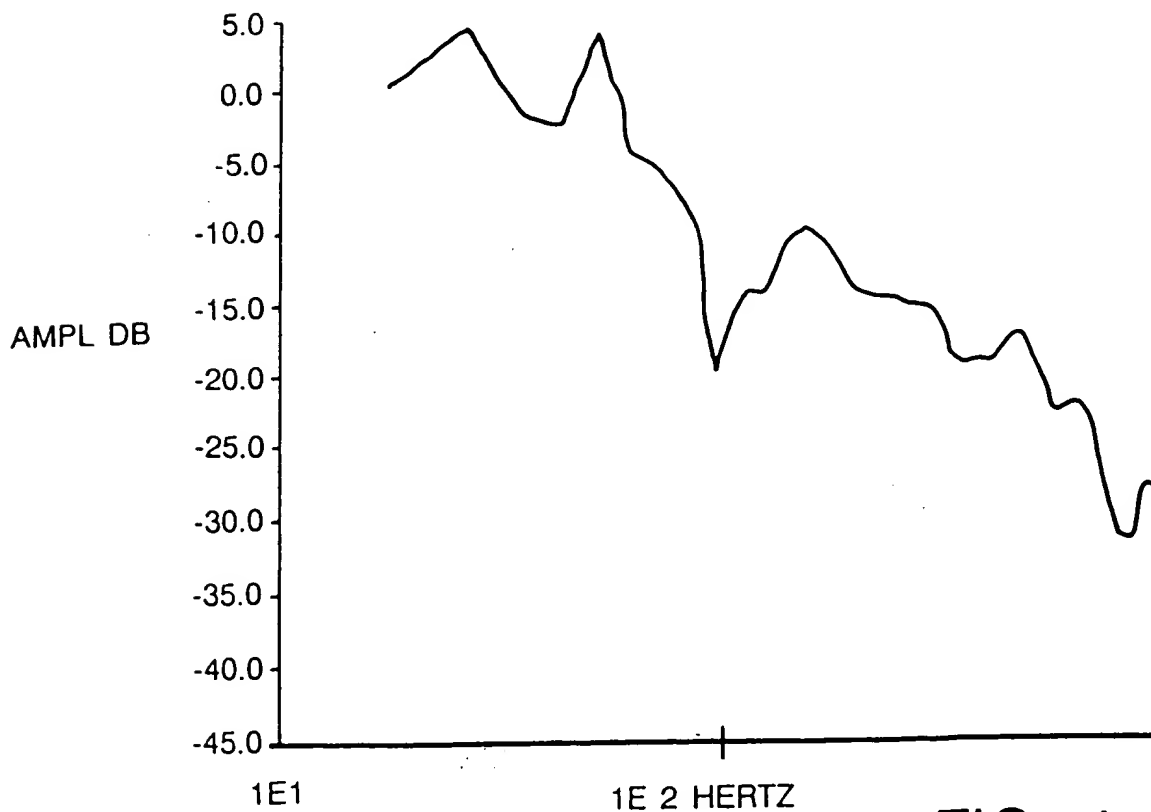


FIG. 4

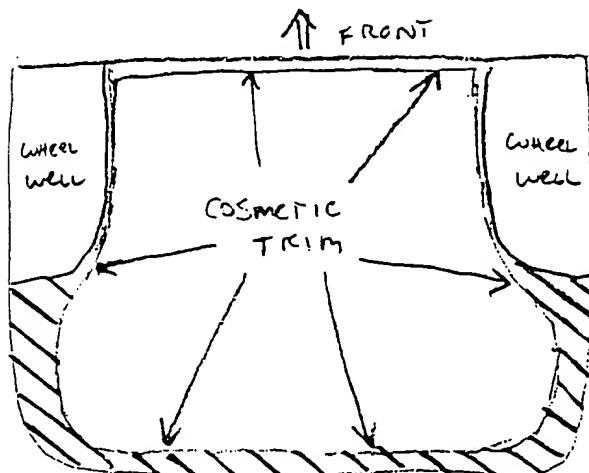


FIG. 5

TOP VIEW OF TRUNK

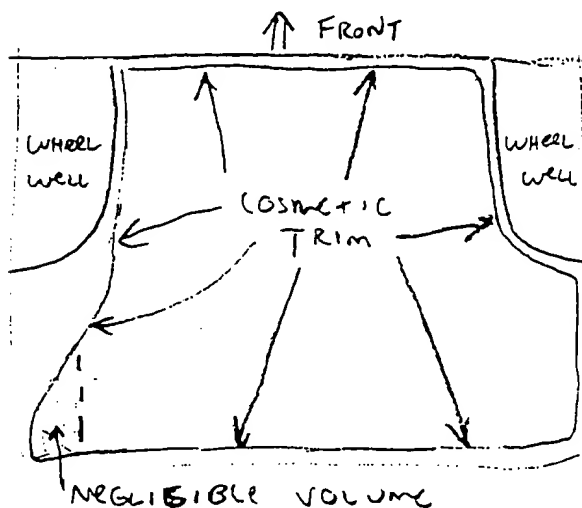
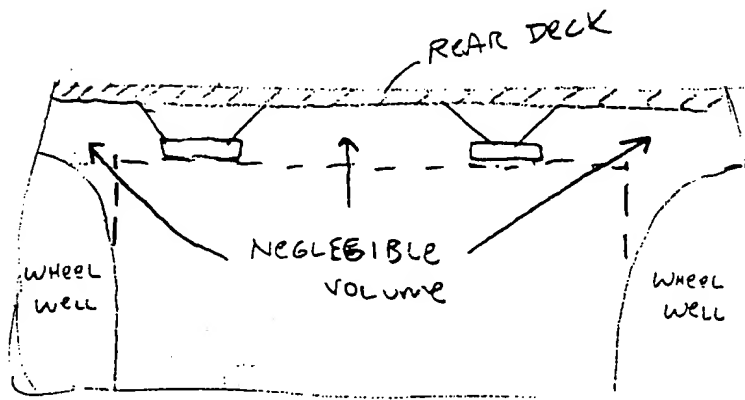


FIG. 6

TOP VIEW OF TRUNK



REAR
SIDE VIEW OF TRUNK

FIG. 7